



TTAB

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

Pramil S.R.L. (Esapharma)

v.

Michel Farah

Cancellation No. 92/032341

On Petition to the Director
Filed: September 1, 2005

Decision

Michel Farah, the respondent in the above-identified cancellation proceeding, has petitioned the Director to reverse the decisions of the Trademark Trial and Appeal Board dated March 28, 2005 and July 19, 2005. The petition is denied.

Facts

The subject registration was issued to respondent on May 1, 2001. On October 25, 2005, Pramil S.R.L. (Esapharma) ("Pramil") filed a petition to cancel the registration. Respondent filed motions to extend his testimony period on November 29, 2004 and December 23, 2004. On March 1, 2005, respondent filed a third motion to extend his testimony period until April 14, 2005, asserting that "Registrant and his undersigned attorney have been unable to prepare, schedule and present Registrant's testimony and evidence during [the allotted] time. At present, efforts are underway to reschedule the Registrant's testimony during the month of March 2005, in conjunction with the discovery deposition of Mr. Farah in a federal court proceeding involving related parties and the same attorneys." Pramil filed an objection to this motion on March 2, 2005, along with its main trial brief.

On March 28, 2005, the Board issued an order in which it granted the first two motions to extend respondent's testimony period through February 28, 2005. The Board construed respondent's third motion to extend his testimony period as a motion to reopen testimony, because it was filed after the testimony period closed, and denied the motion, because respondent had not established that his failure to act during the previously allotted time

period was the result of excusable neglect, as required by Federal Rule of Civil Procedure ("FRCP") 6(b)(2).

The deposition of Michel Farah was taken on March 29, 2005. On April 7, 2005, respondent filed a request for reconsideration of the denial of his motion, asserting that he cannot provide evidence of use of the mark unless the testimony is permitted; that documentary evidence of first use of the mark had to be obtained from a closed company in the United Kingdom; that despite his efforts he had not been able to obtain the evidence prior to the expiration of the previously allotted time; that he was attempting to accommodate the request of Pramil's counsel to coordinate the taking of respondent's testimony with the taking of his deposition in another pending case; that he sent a fax to Pramil's counsel on March 1, 2005 asking for dates in March, but received no response; that he did not receive the Board's order dated March 28, 2005 until April 4, 2005, and as such had no notice of the denial at the time the deposition was taken; and that substantial prejudice will result if the testimony is not considered.

Respondent filed the Farah deposition on April 27, 2005. Pramil filed a motion to strike the deposition on May 2, 2005, noting that the deposition was not taken until one month after the testimony period had closed; that its counsel did not attend the deposition because he was out of the country and had no knowledge of its scheduling; and that respondent was aware that Pramil's counsel would be on an extended three week trip beginning on March 12, 2005.

On July 19, 2005, the Board issued an order denying respondent's request for reconsideration and granting Pramil's motion to strike the deposition. The Board noted that a motion for reconsideration is a device that may be used to show that an order of the Board was erroneous based on the facts before the Board when it issued the order, and may not be used to introduce into the record facts that were previously known and could have been presented earlier; that respondent did not assert that he was unaware of these facts when he filed the request to reopen; that there was no error in denying the third request based on the reasons stated therein; that the reasons given in the third request for an extension were nearly identical to the reasons stated in the first two motions for extensions, and that the same reasons, without more, did not constitute excusable neglect.

This petition was filed September 1, 2005, under certificate of mailing dated August 17, 2005.¹ On August 23, 2005, Pramil filed a response urging that the Director deny the petition.

¹ It is noted that the certificate of mailing does not meet the requirements of 37 C.F.R. §2.197(a)(1)(i)(A), because the petition was not addressed as set out in 37 C.F.R. §2.190(a). Instead, the certificate indicates that the petition was sent to the prior address of the Office, which changed effective November 1, 2004. However, since the Office's address changed less than a year before the filing of the petition, the Director shall exercise supervisory authority under 37 C.F.R. §§2.146(a)(3) and 2.146(a)(5) to find the certificate of mailing to be substantially in compliance with the rule, and shall consider the petition on the merits.

Standard of Review

The Director will reverse an action of the Board only upon a showing of clear error or abuse of discretion. TMEP §1706; TBMP §906.02. See *Jonergin Co. Inc. v. Jonergin Vermont Inc.*, 222 USPQ 337 (Comm'r Pats. 1983); *Riko Enterprises, Inc. v. Lindsley*, 198 USPQ 480 (Comm'r Pats. 1977).

Motion to Strike Farah Deposition

It is well settled that a party to an *inter partes* proceeding may not take testimony outside of the times assigned by the Board, unless by stipulation of the parties approved by the Board, or, upon motion, by order of the Board. 37 C.F.R. §2.121(a)(1); TBMP §701. See *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070 (TTAB 1990). In this case, it is clear that the parties did not stipulate to the deposition, and the Board had not granted leave to take the deposition. Therefore, it cannot be said that the Board clearly erred or abused its discretion in granting Pramili's motion to strike the deposition.

Request for Reconsideration

As the Board pointed out, the premise underlying a motion for reconsideration of a Board order is that the Board erred in reaching the decision that it issued, based on the facts before it when the decision was issued. Such a motion may not properly be used to introduce additional facts or evidence that could have been presented earlier. Rather, it should be limited to a demonstration that based on the facts before it and the applicable law, the Board's ruling is in error. TBMP §518. See *In re Cosmetically Yours, Inc.*, 171 USPQ 563 (TTAB 1971). In the motion for reconsideration filed April 7, 2005, respondent did not assert that the facts stated therein were not previously available. Therefore, the Board did not clearly err or abuse its discretion in considering only the facts that were before it when it decided respondent's third motion to extend his testimony period.

Under FRCP 6(b)(2), which applies to *inter partes* proceedings before the Board pursuant to 37 C.F.R. §2.116(a), where the time for taking an action has expired, a party desiring to take the action must file a motion to reopen the time for taking that action, showing that the failure to act during the time previously allotted was the result of excusable neglect. In *Pioneer Investment Services Co. v. Brunswick Associates Ltd. Partnership*, 507 U.S. 380 (1993), the U.S. Supreme Court set forth four factors to be considered in determining excusable neglect: (1) the danger of prejudice to the nonmovant; (2) the length of the delay and its potential impact on judicial proceedings; (3) the reason for the delay, including whether it was within the reasonable control of the movant; and (4) whether the movant acted in good faith. See TBMP §509.01(b). Several courts have indicated that the third *Pioneer* factor, the reason for the delay and whether it was within the control of the party requesting the extension of time, may be the most important of these factors. *Thompson v. E.I. du Pont de Nemours & Co., Inc.*, 76 F.3d 530 (4th Cir. 1996); *City of Chanute, Kansas v. Williams Natural Gas Co.*, 31 F.3d 1041 (10th Cir.

1994), *cert denied* 513 U.S. 1191 (1995); *Weinstock v. Cleary, Gottlieb, Steen & Hamilton*, 16 F.3d 501 (2d Cir. 1994).

The Trademark Trial and Appeal Board has said that it views the second and third factors to be the most important. Moreover, the Board has held that in considering the length of the delay and potential impact on proceedings, one must take into account the additional delay arising from time required for filing, briefing and deciding a contested motion to reopen. *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1588 (TTAB 1997) (“The Board, and parties to Board proceedings generally, clearly have an interest in minimizing the amount of the Board’s time and resources that must be expended on matters, such as most contested motions to reopen time, which come before the Board solely as a result of ... inattention to deadlines on the part of litigants or their counsel.”)

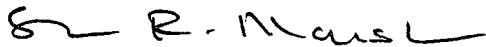
In this case, in his third motion to extend his testimony period, respondent’s stated reason for requesting the extension was that he and his attorney “have been unable to prepare, schedule and present Registrant’s testimony and evidence during that time. At present, efforts are underway to reschedule the Registrant’s testimony during the month of March 2005, in conjunction with the discovery deposition of Mr. Farah in a federal court proceeding involving related parties and the same attorneys.”

The Board found that these statements did not constitute excusable neglect, noting that respondent’s testimony period had already been extended for three months; that the reasons set forth in respondent’s third motion to extend the testimony period were similar to the reasons stated in his first two motions to extend the testimony period; and that respondent had already had ample time to coordinate his testimony period with any other pressing litigation in which he and his counsel were involved. The Board found that “even if we conclude that [Pramil] will not be substantially prejudiced by the delay and that respondent acted in good faith, these factors do not overcome the aforementioned factors which are not in respondent’s favor; nor do they otherwise demonstrate excusable neglect.” Order, March 28, 2005, p. 6. After a careful review of the record and the applicable law, the Director sees no clear error or abuse of discretion in the Board’s finding that respondent failed to establish excusable neglect.

Respondent notes that the Board granted a motion to reopen a testimony period in another proceeding in which he is a party, Opposition No. 91/151621. However, each case must be decided on its own facts, and the fact that the Board granted a motion to reopen in a different case, based on a different record, does not establish that the Board clearly erred or abused its discretion in denying a motion to reopen in the present case.

Decision

The petition is denied.



Sharon R. Marsh
Acting Deputy Commissioner for
Trademark Examination Policy

SRM:MEH

Date: FEB 28 2006

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